

1 Remarks

2 Amendments to the Specification

3 The text of the specification has been amended as indicated above, in order
4 to correct a minor typographical error and to address the Examiner's objection
5 thereto (page 2 of Office action). In particular, the word "holding", as it appears at
6 page 6, line 4 of the specification as originally filed, has been changed to "hold". No
7 new matter has been introduced by way of the amendment to the specification.
8 Therefore, the Applicants respectfully request that the objection to the specification
9 be withdrawn.

10
11 Status of the Claims

12 No claims have been amended, cancelled, withdrawn or added as of this
13 Response. Therefore, the status of the pending claims 1-36 is as provided above.

14
15 Withdrawal of Claim Rejections under 35 U.S.C. § 101

16 The Examiner has stated that the rejection of claims 1-2, 5-8, 10-13 and 15
17 under 35 U.S.C. § 101, as issued by the Examiner in the prior Office action dated
18 January 19, 2005, has been withdrawn (page 2 of Office action). The Applicants
19 hereby acknowledge the withdrawal of the § 101 rejection of claims 1-2, 5-8, 10-13
20 and 15.

21
22 Rejection of Claims under 35 U.S.C. § 102

23 Claims 1, 3-5, 7-13, 16-22, 25, 27-29 and 31-34 have been rejected under 35
24 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No.
25 2001/0037267 A1 ("Sato").

The Applicants respectfully disagree that claims 1, 3-5, 7-13, 16-22, 25, 27-29
and 31-34 are anticipated by Sato.

1 As a starting point, the PTO and the Federal Circuit provide that §102
2 anticipation requires each and every element of the claimed invention to be
3 disclosed in a single prior art reference. (In re Spada, 911 F.2d 705, 15 USPQ2d
4 1655 (Fed. Cir. 1990).) The corollary of this rule is that the absence from a cited
5 §102 reference of any claimed element negates the anticipation. (Kloster
6 Speedsteel AB, et al v. Crucible, Inc., et al, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.
7 1986).) Furthermore, **"[a]nticipation requires that all of the elements and**
8 **limitations of the claims are found within a single prior art reference."** (Scripps
9 Clinic and Research Found. v Genetech. Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d
10 1001, 1010 (Fed. Cir. 1991 (emphasis added).) Moreover, the PTO and the Federal
11 Circuit provide that §102 anticipation requires that there must be no difference
12 between the claimed invention and the reference disclosure. (Scripps Clinic and
13 Research Found. v. Genetech, Inc., id. (emphasis added).)

14 Accordingly, if the Applicants can demonstrate that any one element or
15 limitation in claims 1, 3-5, 7-13, 16-22, 25, 27-29 and 31-34 is not disclosed by Sato,
16 then the respective claim(s) must be allowed.

17 In the following arguments, the Applicants will focus in particular on
18 independent claims 1, 10, 12, 17, 25 and 33 as the Applicants believe those claims
19 to be allowable over Sato. It is axiomatic that any dependent claim which depends
20 from an allowable base claim is also allowable, and therefore the Applicants do not
21 believe it is necessary to present arguments in favor of each and every dependent
22 claim.

23 24 Claim 1

25 The Applicants contend that claim 1 (and rejected claims 3-5 and 7-9, which
depend therefrom), are not anticipated by Sato. With respect to claim 1, that claim
includes the following recitations:

1 A method to promote the use of consumables in an imaging
2 device including a consumption detecting device, comprising:

3 detecting consumption of a consumable using the consumption
4 detecting device; and

5 when the consumption of a predefined quantity of the
6 consumable has been detected, **rewarding** a user of the imaging
7 device.

8 (Emphasis added.)

9
10 Sato fails to provide when the consumption of a predefined quantity of the
11 consumable has been detected, **rewarding** a user of the imaging device, as recited
12 in combination with the other features and limitations of claim 1. In fact, Sato is
13 completely devoid of any reference to a reward, or any of its respective equivalents,
14 in any context.

15 Rather, Sato is directed to periodically transmitting data regarding the number
16 of sheet media (i.e., paper) printed thus far (by an imaging device), or an indication
17 that a toner cartridge is low, to a centralized service center for purposes of initiating
18 a cartridge collection/replacement procedure and the issuance of a *billing statement*
19 to the user of the sheet media and/or toner (Abstract; Paragraphs 0099 and 0138, et
20 seq., of Sato). The Examiner has referred to Figure 16 of Sato in support of his
21 assertion that Sato provides for "rewarding the user of the imaging device(s) ..." and
22 "displaying a reward message on the display" (page 3 of Office action).
23 Respectfully, the Examiner is mistaken.

24 In fact, Figure 16 of Sato depicts one embodiment of a *billing statement*
25 according to Sato - not a *reward* - and is clearly identified as such by the word
"INVOICE" that appears at the top center thereof. Furthermore, the term "PAYABLE
AMOUNT" is also prominently depicted in Figure 16. Such "payable amount" refers

1 to the monetary payment that is due from the user to the service center (or an
2 associated entity) in accordance with the used sheet media and/or toner. As such,
3 Figure 16 cannot be reasonably construed as depicting or referring to a *reward* in
4 any way, and certainly not as the term "reward" is used in the instant application
5 (see at least page 7, lines 3-25 of the specification as originally filed). In any case,
6 the Applicants contend that Sato fails to provide at least one element as positively
7 recited by claim 1. As such, the § 102 rejection of claim 1 is unsupportable and
8 should be withdrawn.

9 For at least these reasons, the Applicants assert that claim 1 is allowable. As
10 rejected claims 3-5 and 7-9 depend (directly or indirectly) from claim 1, it is axiomatic
11 that they too are allowable at least by virtue of their dependence from an allowable
12 base claim, as well as for their own respectively patentable features and limitations.

13
14 Claim 10

15 The Applicants contend that claim 10 (and rejected claim 11, which depends
16 therefrom), are not anticipated by Sato. With respect to claim 10, that claim includes
17 the following recitations:

18
19 A method to promote the use of a plurality of consumables in an
20 imaging device including one or more consumption detecting devices,
21 comprising:

22 detecting consumption by the imaging device of individual
23 quantities of the plurality of consumables using at least one of the one
24 or more consumption detecting devices;

25 when a predefined collective quantity of the individual quantities
of consumables has been detected, rewarding a user of the imaging
device with a reward defined by a value; and

1 basing the value of the reward on the individual quantities of
2 each consumable that has been detected as being consumed by the
3 imaging device.

4 (Emphasis added.)

5
6 Sato fails to provide rewarding a user of the imaging device with a reward
7 defined by a value, as recited as recited in combination with the other features and
8 limitations of instant claim 10. Also, Sato fails to provide basing the value of the
9 reward on the individual quantities of each consumable that has been detected as
10 being consumed by the imaging device, as recited as recited in combination with the
11 other features and limitations of instant claim 10.

12 Again, Sato fails to provide, teach or suggest *rewarding a user*, or any other
13 sort of system or method related to a *reward*, in any context. Sato is concerned with
14 a billing and restocking (i.e., re-provisioning) system and is not concerned with
15 rewards (or other equivalent incentives) to users. For this reason at least, Sato fails
16 to provide at least two limitations as positively recited by claim 10.

17 In view of the foregoing, the Applicants assert that claim 10 is allowable. As
18 claim 10 is allowable, it is axiomatic (automatic, really) that claim 11 is also allowable
19 at least by virtue of its dependence from allowable claim 10.

20
21 Claim 12

22 The Applicants contend that claim 12 (and rejected claims 13 and 16 that
23 depend therefrom), are not anticipated by Sato. With respect to claim 12, that claim
24 includes the following recitations:

25
 A method to promote the use of a consumable in a plurality of
 imaging devices, each of the plurality of imaging devices including a

1 consumption detecting device, the method comprising:

2 detecting consumption of individual quantities of the
3 consumable by each of the imaging devices using the consumption
4 detecting device of each imaging device; and

5 when a predefined collective quantity of the individual quantities
6 of consumable has been detected, generating a reward.

7 (Emphasis added.)
8

9 Sato fails to provide, when a predefined collective quantity of the individual
10 quantities of consumable has been detected, generating a reward, as recited as
11 recited in combination with the other features and limitations of instant claim 12. For
12 at least this reason, and for reasons analogous to those provided above in regard to
13 instant claims 1 and 10, the Applicant assert that the § 102 rejection of instant claim
14 12 is lacking support and must be withdrawn.

15 Therefore, the Applicants assert that claim 12 is allowable. It is axiomatic that
16 claims 14-15 are also allowable at least by virtue of their respective dependence (be
17 it direct or indirect) from allowable claim 12.
18

19 Claim 17

20 The Applicants contend that claim 17 (and rejected claims 18-22, which
21 depend therefrom), are not anticipated by Sato. With respect to claim 17, that claim
22 includes the following recitations:
23

24 Apparatus for providing the user of an imaging device, which is
25 configured to consume a consumable, with a reward based on a
consumption of the consumable by the imaging device, comprising:

[...]; and

1 a processor configured to receive the consumption signals and
2 to store a consumption value in the electronic writeable memory
3 device, the consumption value being a function of the received
4 consumption signals, the processor further configured to read from the
5 readable memory device the user reward message when the
6 consumption value is at least equal to a predetermined reward value,
7 and to visually display the reward message to the user.

8 (Emphasis added.)
9

10 Sato fails to provide a processor further configured to read from the readable
11 memory device the user *reward* message when the consumption value is at least
12 equal to a predetermined *reward* value, and to visually display the *reward* message
13 to the user, as recited in combination with the other features and limitations of
14 instant claim 17. Sato fails to provide or suggest a user reward message, or
15 displaying such a user reward message, in any way or for any purpose, as already
16 discussed above with respect to claims 1, 10 and 12.

17 In view of the substantive deficiencies of Sato, and in further view of the
18 requirements for supporting a § 102 rejection as cited above, the Applicants assert
19 that claim 17 is allowable. As claims 18-22 depend (directly or indirectly) from
20 allowable claim 17, it is axiomatic that they too are allowable.
21

22 Claim 25

23 The Applicants contend that claim 25 (and rejected claims 27-29 and 31-32
24 that depend therefrom), are not anticipated by Sato. With respect to claim 25, that
25 claim includes the following recitations:

A computer-readable storage medium for use by a processor

1 configured to execute computer executable instructions to generate a
2 reward message in response to the consumption of a consumable by
3 an imaging device, the medium holding computer executable
4 instructions to:

5 detect consumption of the consumable; and
6 when the consumption of a predefined quantity of the
7 consumable has been detected, generate a reward message.

8
9 Sato fails to provide computer executable instructions to, when the
10 consumption of a predefined quantity of the consumable has been detected,
11 generate a reward message, as recited in combination with the other features and
12 limitations of instant claim 25, and as already discussed above with respect to claims
13 1, 10, 12 and 17. Therefore, Sato fails to provide at least one limitation as positively
14 recited by claim 25. The § 102 rejection of claim 25 is unsupportable in view of at
15 least this deficiency of Sato, and the rejection should be withdrawn.

16 For at least these reasons, the Applicants assert that claim 25 is allowable.
17 Rejected claims 27-29 and 31-32 are also allowable at least by virtue of their
18 respective dependencies (direct or indirect) from allowable claim 25.

19
20 Claim 33

21 The Applicants contend that claim 33 (and rejected claim 34 that depends
22 therefrom), are not anticipated by Sato. With respect to claim 33, that claim includes
23 the following recitations:

24
25 A computer-readable storage medium for use by a processor
configured to execute computer executable instructions to generate a
reward message in response to the consumption of at least one

1 consumable by an imaging device, the medium holding computer
2 executable instructions to:

3 [...];

4 generate the reward message when the consumption value is at
5 least the predetermined reward value and;
6 visually display the reward message.

7 (Emphasis added.)
8

9 Sato fails to provide generat[ing] the reward message when the consumption
10 value is at least the predetermined reward value, as recited in combination with the
11 other features and limitations of instant claim 33, and as already discussed above
12 with respect to claims 1, 10, 12, 17 and 25. Also, Sato fails to provide visually
13 display[ing] the reward message, as recited in combination with the other features
14 and limitations of instant claim 33.

15 For at least these reasons, the Applicants assert that Sato fails to provide at
16 least two limitations as positively recited by claim 33. Thus, the Applicants contend
17 that claim 33 is allowable, and the § 102 rejection there against must be withdrawn.
18 As claim 34 depends from claim 33, it is automatic (that is, axiomatic) that it too is
19 allowable at least by virtue of its dependence from an allowable base claim, as well
20 as for its own respectively patentable features and limitations.
21

22 Rejection of Claims under 35 U.S.C. § 103

23 Claims 2, 14, 26 and 36 have been rejected under 35 U.S.C. § 103(a) as
24 being unpatentable over Sato, in view of U.S. Patent No. 5,401,946 ("Weinblatt").
25 Claims 6, 15, 23, 24, 30 and 35 have been rejected under 35 U.S.C. § 103(a) as
being unpatentable over Sato, in view of U.S. Patent No. 6,418,283 ("Wegman").

1 Rejected claims 2 and 6 depend (directly or indirectly) from claim 1. Claims
2 14-15 depend from claim 12. Claims 23-24 depend from claim 17. Claims 26 and
3 30 depend from claim 25. Claims 35-36 depend from claim 33. As stated above, the
4 Applicants assert that independent claims 1, 12, 17, 25 and 33 are allowable. It is
5 axiomatic that any claim depending, directly or indirectly, from an allowable base
6 claim is itself allowable. Therefore, the Applicants assert that claims 2, 6, 14, 15, 23,
7 24, 26, 30, 35 and 36, as respectively rejected under § 103, are also allowable at
8 least by virtue of their respective dependence from allowable independent claims 1,
9 12, 17, 25 and 33. As such, the Applicants do not believe it necessary to provide
10 arguments in favor of the rejected dependent claims.

11
12 Summary

13 The Applicants believe that this response constitutes a full and complete
14 response to the Office Action. In view of the foregoing, the Applicants respectfully
15 request reconsideration on the merits of claims 1-36 in favor of timely allowance.

16 The Examiner is respectfully requested to contact the below-signed
17 representative if the Examiner believes this will facilitate prosecution toward
18 allowance of the claims.

19
20 Respectfully submitted,

21 Travis J. Parry and Robert Seek

22
23 Date: August 31, 2005

24 By John S. Reid

25 John S. Reid
Attorney and Agent for Applicants
Reg. No. 36,369
Phone: (509) 534-5789